

Appl. No. 09/560,836  
Reply to Office action of 11/22/2004

### **REMARKS**

Based on the above amendments and following remarks, this application is deemed to be in condition for allowance and action to that end is respectfully requested.

#### **Disposition of Claims in Office Action**

Claims 46-48 are pending in the application. Claims 46-48 stand rejected.

#### **Summary of Amendments To Claims**

Applicant has cancelled claims 46-48 and rewritten them as new claims 49-73. The new claims, among other things, more particularly define the Applicant's invention. It is believed that no new matter has been added.

#### **Response to Claim Rejections – 35 U.S.C. § 112**

The Examiner rejected claim 48 under 35 U.S.C. 112, second paragraph, because claim 48, among other things, lacks sufficient antecedent basis. Claim 48 has now been cancelled. Accordingly, withdrawal of this rejection is respectfully requested.

#### **Response To Claim Rejections - 35 U.S.C. § 103(a)**

The Examiner rejected claims 46-48 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,053,536 to Clevenstine (Clevenstine) in view of U.S. Patent No 6,167,382 to Sparks *et al.* (Sparks). Applicant respectfully requests reconsideration of this rejection.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references (or references when combined)

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must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on an applicant's disclosure in the specification. See In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Applicant respectfully submits that the claims are not obvious in view of the references because the combination of Clevensine in view of Sparks is missing several limitations of each of claims 49-73.

In one exemplary embodiment of the present invention, Applicant claims a method of advertising, comprising: providing a user terminal; providing a web site for user registration; the web site for providing advertising data to the user terminal; providing a printer for printing pages of data; providing other data to be printed; printing the advertising data together with the other data to be printed; and recording credits for the user on the web site based on the quantity of pages printed with the advertising data.

Applicant's invention is fundamentally different from that of Clevensine and Sparks. Specifically, neither Clevensine or Sparks teach or disclose recording on a website user earned rewards, points or other credits for, e.g., merchandise or services, based on the quantity of pages printed with advertising data. Applicant's invention is directed to a different problem than Clevensine and Sparks, and such different problem is recited in the claims.

Given the foregoing, Applicant submits that the claims distinguish over the references and are not rendered obvious. Accordingly, withdrawal of this rejection is respectfully requested.

Appl. No. 09/560,836  
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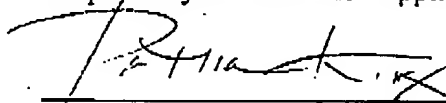
### CONCLUSION

In view of the foregoing amendments and remarks, it is respectfully submitted that the application is in condition for allowance and accordingly, allowance of the application is respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place the case in condition for final allowance, then it is respectfully requested that such amendment or correction be carried out by Examiner's Amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

The Commissioner is authorized to charge any required fees, including any extension and/or excess claim fees, any additional fees, or credit any overpayment to Deposit Account 06-0923. Applicant claims small entity status. See 37 C.F.R. 1.27.

Respectfully submitted for Applicants,



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